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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,870	03/25/2004	Hideo Inoue	MM4703	7467

7590 11/20/2006

WYATT, GERBER, MELLER & O ROURKE, L.L.P.  
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NEW YORK, NY 10016

EXAMINER
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DANIELSEN, NATHAN ANDREW

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/808,870

Applicant(s)

INOUE ET AL.

Examiner

Nathan Danielsen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 03/25/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-15 are pending.

#### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Claim Objections*

3. Claim 8 is objected to because the order in which the limitations are presented renders the claim confusing. The examiner suggests changing claim 8 to read --The apparatus defined in claim 7 further comprising means for changing said allowable level, wherein said allowable level is stored in RAM of said processing means.--. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites the limitations "said scratching means" and "said operation means". Claim 2 recites the limitation "the surfaces". There is insufficient antecedent basis for these limitations in the claims.

7. Claim 1 is further rejected as being indefinite because it is unclear how the rotational speed (not rotational speed signal) of said first operation means and that (again, not rotational speed signal) of said second operation means, both being achieved at the *same* rotational speed, *differ* from each other (emphasis added).

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8. Claims 11-13 are rejected as being indefinite because it is unclear if the claimed "a signal" is meant to encompass the claimed rotational signals in claim 11 or a completely different signal.
9. Claim 13 is further rejected as being indefinite because it is unclear in light of the specification what the phrase "standing between" means.
10. Claims 3-9 are rejected as being dependent on an indefinite claim.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Thomas Brown (US Patent Application Publication 2003/0063066; hereinafter Brown).

Regarding claim 10, Brown discloses an audio signal reproduction apparatus, comprising:

rotational operation means (jog dials 4 and 5 in figure 1); and

processing means which reproduces an audio signal recorded on an optical disk in accordance

with at least a rotational signal representing an operation speed of said rotational

operation means and which outputs said audio signal as scratch sound (mixing deck

processor 32 in combination with PC processor 42), wherein

said rotational operation means includes first and second rotational operation means (jog dials 4

and 5); and

said processing means has conversion means for converting at least either a rotational signal

output from said first rotational operation means or a rotational signal output from said

second rotational operation means such that an identical rotational signal is achieved

when said first and second rotational operation means are rotated at the same rotational

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speed (inherent in ¶ 39; where either of jog dials 4 and 5 may be used to simulate a DJ scratch effect and the rotational velocity of each must be determined accurately).

***Citation of Relevant Art***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. Yamada et al (US Patent Application Publication 2001/0011497) disclose an apparatus utilizing a jog dial for the generation of DJ scratch effects;
  - b. Inoue et al (US Patent Application Publication 2001/0017832) and Roman et al (US Patent Application Publication 2005/0259532) disclose an apparatus which utilizes two jog dials for the generation of DJ scratch effects;
  - c. Luciano et al (US Patent 5,763,874) disclose an optical encoder which functions in a manner at least similar to that disclosed in the instant application;
  - d. Huang (US Patent 7,072,249) and Liu (US Patent 6,535,462) disclose apparatuses which utilize a turntable for the generation of DJ scratch effects;
  - e. Huang (US Patent Application Publication 2006/0039245) discloses an apparatus which has a rotary wheel and separate from a turntable, both of which are usable to generate DJ scratch effects; and
  - f. Shim et al (US Patent Application Publication 2005/0052981) disclose an apparatus which utilizes a jog dial and a turntable for the generation of DJ scratch effects.

***Allowable Subject Matter***

14. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
15. Claims 11-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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16. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
17. The following is a statement of reasons for the indication of allowable subject matter:
18. The prior art of record, either alone or in combination, fails to teach or fairly suggest:
  - a. In claims 1 and 14, first and second operation means which are different from each other and operated in combination with a processing means; and
  - b. In claims 11-13, conversions means which make use of ratios between the output signals of the first and second operation means in converting a signal.

***Closing Remarks/Comments***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Danielsen whose telephone number is (571) 272-4248. The examiner can normally be reached on Monday-Friday, 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on (571) 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan Danielsen  
11/09/2006

ND

  
THANG V. TRAN  
PRIMARY EXAMINER